

### **REMARKS**

By the foregoing, claims 13, 20, 24, 28, 40, 42, and 49 have been amended; claims 11-12, 22, and 51 were previously canceled; and claims 1-10, 30-39, and 59-73 were previously withdrawn. The Applicant submits that the amendments made herein are fully supported in the specification, claims and/or the drawings, as originally filed, and therefore no new matter has been introduced. Claims 13-21, 23-29, 40-50, 52-58, and 74-82 are subject to examination and pending in the present application.

#### **I. Claims 74-82**

The Examiner did not reject claims 74-82. Therefore, the Applicant assumes that claims 74-82 are allowable.

#### **II. Claims 13-19, 40-50, 52, 54-58**

Claims 13-19, 40-50, 52 and 54-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,449,330 issued to Lucas et al. ("Lucas") in view of U.S. Patent No. 5,146,552 issued to Cassorla et al. ("Cassorla") and further in view of U.S. Patent No. 5,467,102 issued to Kuno et al. ("Kuno"). The Applicant notes that claims 13, 40, and 42 have been amended. To the extent that this rejection applies to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

The Applicants submit that neither Cassorla nor Kuno disclose or suggest a method for displaying at least one selected page of an electronic book displayed on a viewer having of hardware screens, each capable of being physically and electrically attached to and separated from each other, including

at least determining the number of hardware screens currently attached in the viewer and formatting the selected page for display on the screens of the viewer, as recited in amended claim 13.

For at least this reason, the Applicant respectfully submits that claim 13, as amended, is allowable over the cited art. For similar reasons, the Applicant submits that claims 40 and 42 are likewise allowable.

As amended claims 13 is allowable, the Applicant submits that claims 14-19 and 74-75, which depend from allowable claim 13, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

For similar reasons to those discussed with regard to claim 13, the Applicant submits that claims 40 and 42 are allowable over the cited art. As amended claims 40 and 42 are allowable, the Applicant submits that claims 41 and 43-48, each of which depends from one of allowable claims 40 or 42, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

### **III. Claims 20-21, 23-29, 53, and 76-82**

Claims 20-21, 23, and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla. Claims 24 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla and further in view of U.S. Patent No. 5,625,833 to Levine et al. ("Levine"). It is noted that claims 20, 24, 28, 49, and 53 have been amended. To the extent that these rejections apply to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

The Applicants' submit that Lucas does not disclose or suggest a method for simultaneously displaying on a viewer a selected portion of an electronic book and content from a separate information source including at least the combination of receiving a request from a subscriber for displaying at least a portion of the electronic book and, afterward, receiving a request for simultaneously displaying the content from a separate information source, wherein the separate information source is at least one selected from the group consisting of a second electronic book, a television signal, a video signal, a still photo, content from the Internet, and electronic book electronic links, and displaying the content from the information source as an inset page, fully inset within the displayed portion of the electronic book, as recited in amended claim 20.

Cassorla and Levine do not cure the deficiencies in Lucas.

For at least this combination of reasons, the Applicant submits that claim 20, as amended, is allowable over the cited art. As claim 20 is allowable, the Applicant submits that claims 21, 23- 29, and 76-79, which depend from claim 20, are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

For similar reasons to those discussed with respect to claim 20, the Applicant submits that amended claims 24, 28, 49, 53 and 57 are allowable over the cited art. As amended claims 24, 28, 49, 53 and 57 are allowable, the Applicant submits that claims 25-27, 29, and 80-82, each of which depends from

one of allowable claims 24, 28, or 53 are likewise allowable for at least the above noted reasons and for the additional limitations they provide.

#### **IV. Claims 24 and 53**

Claims 24 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla and further in view of Levine.

The Examiner admits that Lucas and Cassorla do not disclose or suggest an apparatus for simultaneously displaying on a viewer a selected portion of an electronic book and content from a separate information source, wherein a display module displays the portion of the electronic book as wrapping around the displayed content from the information source.

The Office Action asserts that Levine teaches automatically wrapping a word to the next line when a typing cursor comes close by margins in a document, and thus, it would be obvious to wrap text around document contents. However, the Applicants submit that Levine merely teaches wrapping a word when it is dealing with the margin within its own document. In Levine, the document is formatting itself based on its own contents. In the invention recited in claim 53, the display of the electronic book is reformatted to wrap around content that is not part of the electronic book. Levine does not disclose or suggest a format module that formats the electronic book and the content from a separate information source for simultaneous display, wherein the display module displays the portion of the electronic book as wrapping around the displayed content from the information source, as recited in claim 53.

For at least this combination of reasons, the Applicant submits that claim 53 is allowable over the cited art. For similar reasons, the Applicant submits that claim 24 is likewise allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 4, 5, and 7-11. This is an insufficient showing of motivation.

**CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into condition for allowance, the Examiner is encouraged to telephone the undersigned representative.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00020.

Respectfully submitted,

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